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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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20350 7590 03/10/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
			EXAMINER HAYES, JOHN W	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* JEFFREY G. NOWLIN, SCOTT J. SMITH, and FRED C. CASTO
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11 Appeal 2008-2779
12 Application 10/028,888
13 Technology Center 3600
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16 Decided:¹ March 10, 2009
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19 *Before* ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
20 MOHANTY, *Administrative Patent Judges*.

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22 FETTING, *Administrative Patent Judge*.
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25 DECISION ON APPEAL
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28 STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Jeffrey G. Nowlin, Scott J. Smith, and Fred C. Casto (Appellants) seek review under 35 U.S.C. § 134 of a non-final rejection of claims 1, 2, 4, 6-16, 18-22, and 27-35, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We REVERSE.

The Appellants invented a way for determining the proper postage of mailings without physically weighing each mailing (Specification 1:¶ 01).

An understanding of the invention can be derived from a reading of exemplary claims 1 and 15, which are reproduced below [bracketed matter and some paragraphing added].²

1. In a system for assembling a mailing unit for mailing, wherein the mailing unit is formed from a plurality of components including inserts and envelopes that are provided to the system; a method for producing and weighing the mailing unit, comprising:

[1] determining a weight for each of the components of the mailing unit and electronically storing a record of the weights at a memory in the system;

[2] printing at the system an identifier on one of the components forming the mailing unit after that one of the components has been provided to the system, wherein the identifier is used in identifying the components of the mailing unit;

[3] reading the identifier to determine the components of the mailing unit;

[4] placing the inserts into the envelope to form the mailing unit;

² The claims currently entered in the record are not those in the exhibit at the end of the Appeal Brief, but rather those in the Amendment After Non-Final Rejection filed on July 1, 2004.

1 [5] determining the weight of the mailing unit based on the
2 weights of the components utilized to form the mailing unit that
3 are stored in the memory as a weight record.
4

5 15. A system for producing and weighing mailing units that are
6 formed from a plurality of components including inserts and
7 envelopes, the system comprising:

8 [1] a controller having a processor and a memory containing the
9 weight of each of the components;

10 [2] a printer for printing an identifier on one of the components
11 forming the mailing unit after that one of the components has
12 been provided to the system, wherein the identifier is used to
13 identify the components of the mailing unit;

14 [3] a reader for reading the identifier and providing the
15 identifier to the controller;

16 [4] a movable track;

17 [5] a plurality of inserting locations that are adapted to hold the
18 inserts, and a plurality of inserting mechanisms that are adapted
19 to place selective ones of the inserts onto the track; and

20 [6] a moving mechanism that is adapted to move the inserts
21 from the track and into an envelope to form a mailing unit;

22 [7] wherein the controller is configured to determine the
23 components of the mailing unit based on the identifier and to
24 determine the weight of the mailing unit based on the weights
25 of the components utilized to form the mailing unit that are
26 stored in the memory.
27

28 This appeal arises from the Examiner's Non-Final Rejection, mailed
29 May 4, 2004. The Appellants filed an Appeal Brief in support of the appeal
30 on July 1, 2004. An Examiner's Answer to the Appeal Brief was mailed on
31 September 13, 2007. A Reply Brief was filed on November 9, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Long EP 0 621 563 A1 Oct. 26, 1994

REJECTION³

Claims 1, 2, 4, 6-16, 18-22 and 27-35 stand rejected under 35 U.S.C. § 102(b) as anticipated by Long.

ISSUE

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 4, 6-16, 18-22 and 27-35 under 35 U.S.C. § 102(b) as anticipated by Long.

The pertinent issue turns on whether Long describes limitation [2] of printing at the system an identifier on one of the components forming the mailing unit after that one of the components has been provided to the system, wherein the identifier is used in identifying the components of the mailing unit; and [3] of reading the identifier to determine the components of the mailing unit.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

³ The rejection in the Answer omits claim 4 (Answer: 4), but claim 4 is included in the rejection in both the Non-Final Rejection at 3 and the Brief at 2. Accordingly, the omission in the Answer is taken to be a typographic error and claim 4 is included within the scope of the rejection for the purposes of this appeal.

Long

01. Long is directed to preparing letters for mailing (Long: Title).
02. Long has a reader that reads a data card. The information read from the data card is used to select inserts to be combined and to indicate the weight of the completed envelope (Long 6:9-14).
03. The data card stores its data in a magnetic stripe or other data storage medium and is placed in a card feeder above the printing web path (Long 3:5-11).
04. The printer may print a name and address in a letter to which the data card will be affixed. The printer may also print driver license or credit card information (Long 6:15-44).

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant

must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

ANALYSIS

Claims 1, 2, 4, 6-16, 18-22, and 27-35 rejected under 35 U.S.C. § 102(b) as anticipated by Long.

Independent claim 1 is directed toward a method and independent claim 15 is directed toward a system. The Examiner treated claim 15 as representative of the group of claims and found that Long anticipated claim 15 (Answer 3-4). The Appellants contend that Long does not describe limitation [2] of printing at the system an identifier on one of the components forming the mailing unit after one of the components has been provided to the system, wherein the identifier is used in identifying the components of the mailing unit; and [3] of reading the identifier to determine the components of the mailing unit.

We agree with the Appellants. The Examiner found that in a system claim, anticipation requires the capacity for intended use, not the performance (Answer 5). The Examiner failed to show that Long has such a capacity.

The Examiner's findings are that the identifier printed by Long is a credit card number or driver license number or other identifying information (Answer 3). Long does indeed print such identifiers (FF 04). Long's reader does not read these identifiers, however. Instead, Long's reader (Long Fig 2:34) reads data cards that have identifiers pre-stored in computer readable format (FF 02 & 03). The Examiner identifies Long's z-fold sheet sensor (Long Fig 2:66) and web section sensor (Long Fig. 2:27) as such readers, but these are sensors for manipulating the sheets and there is no evidence they possess the capacity for reading identifiers.

The Examiner found that Long's identifier was information in a data record (Answer 5). This is not the identifier required by each of the independent claims. Each independent claim requires that the identifier that is read and that is used to determine weight be the same identifier that was

1 printed by the printer. Long does not do so and the Examiner has not shown
2 otherwise. The information on Long's data cards, which would be the
3 information in a data record found by the Examiner, is not printed by Long's
4 printer. Thus, Long does not exhibit the capacity to perform any of the
5 independent claims.

6
7 **CONCLUSIONS OF LAW**

8 The Appellants have sustained their burden of showing that the
9 Examiner erred in rejecting claims 1, 2, 4, 6-16, 18-22, and 27-35 under 35
10 U.S.C. § 102(b) as anticipated by Long.

11
12 **DECISION**

13 To summarize, our decision is as follows:

- 14 • The rejection of claims 1, 2, 4, 6-16, 18-22, and 27-35 under 35
15 U.S.C. § 102(b) as anticipated by Long is not sustained.

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17 **REVERSED**
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